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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/428,641	10/27/99	DORF	R 751473/017

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MM92/0621

EXAMINER	
FELTEN,D	
ART UNIT	PAPER NUMBER
2876	<i>4</i>
DATE MAILED:	
06/21/00	

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. 09/428,641	Applicant(s) Dorf, R.
	Examiner Daniel Felten	Group Art Unit 2876

Responsive to communication(s) filed on Oct 27, 1999

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claim

Claim(s) 32-65 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 32-65 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

- 1      1. Receipt of the preliminary amendment filed October 27, 1999 canceling claims 1-31  
2 and adding claims 32-65 is acknowledged.

3

4      *Double Patenting*

- 5      2. The nonstatutory double patenting rejection is based on a judicially created doctrine  
6 grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or  
7 improper timewise extension of the "right to exclude" granted by a patent and to prevent  
8 possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29  
9 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985);  
10 *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438,  
11 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA  
12 1969).

13      A timely filed terminal disclaimer in compliance with 37 CFR 1.321(e) may be used to  
14 overcome an actual or provisional rejection based on a nonstatutory double patenting ground  
15 provided the conflicting application or patent is shown to be commonly owned with this  
16 application. See 37 CFR 1.130(b). *m*

17      Effective January 1, 1994, a registered attorney or agent of record may sign a terminal  
18 disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37  
19 CFR 3.73(b).

- 20      3. Claims 32-65 are rejected under the judicially created doctrine of double patenting over  
21 claims 1-66 of U. S. Patent No. 6,000,608 since the claims, if allowed, would improperly  
22 extend the "right to exclude" already granted in the patent.

1           The subject matter claimed in the instant application is fully disclosed in the patent and  
2       is covered by the patent since the patent and the application are claiming common subject  
3       matter, as follows:

4           Re claims 32-49, the applicant claims a multifunction card system (see Abstract), a

5       prepaid phone card system, and a loyalty card system, comprising:

6           a.       a electronic gift certificate card (see col. 3, lines 9-27; and col. 11, lines 41-  
7       65)/prepaid phone card (see col. 3, lines 28-41; and col. 12, lines 42-65)/loyalty card (see col.  
8       3, lines 42-53; and col. 14, lines 28-43) having a unique identification number approved by  
9       the American Banking Association for use in a banking network (see col. 4, lines 36-46), the  
10      identification number corresponding to a multifunction card system/prepaid phone card  
11      system/loyalty card system;

12           b.       a banking processing hub computer under bank hub software control and in  
13      communication over a banking/credit/debit network with a pre-existing standard retail point-  
14      of-sale device (see col. 4, lines 29-32), the bank processing hub computer receiving electronic  
15      gift certificate card/phone card activation data/ when the electronic gift certificate card/phone  
16      card is swiped through the point-of-sale device (see col. 4, lines 33-35), the electronic gift  
17      certificate/phone card activation data comprising the unique identification number of the  
18      electronic gift certificate card/phone card and an electronic gift activation/phone card  
19      activation amount (see col. 4, lines 34-46): and

1                   c.        a gift certificate/medical card/phone card computer under gift certificate  
2        software control and in communication with the bank processing hub for activating a gift  
3        certificate/medical card/phone card account in a gift certificate card data base corresponding to  
4        the electronic gift certificate card/medical card/phone card, the gift certificate card/medical  
5        card/phone card account comprising balance data representative of an electronic gift  
6        certificate/medical card/phone card activation amount (see col. 3, lines 9-63).  
7

8                   Re claims 50-65, Dorf discloses a method of activating or recharging a magnetically  
9        encoded gift certificate (col. 11, lines 41-65)/phone card (see col. 12, lines 42-65)/loyalty card  
10      (col. 14, lines 28-43)/medical card ( col. 18, lines 26-34) having a unique identification  
11      number on it approved by the American Banking Association for use in a banking network, the  
12      identification number corresponding to an electronic gift certificate card/phone card/loyalty  
13      card/medical card system.

14                  Furthermore, there is no apparent reason why applicant was prevented from presenting  
15      claims corresponding to those of the instant application during prosecution of the application  
16      which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA  
17      1968). See also MPEP § 804.  
18

*Conclusion*

1  
2  
3     1. Any inquiry concerning this communication or earlier communications from the examiner  
4     should be directed to **Daniel S. Felten** whose telephone number is (703) 305-0724. The  
5     examiner can normally be reached between the hours of 7:30AM to 6:00PM Monday, Tuesday,  
6     Thursday, and Friday.

7                 If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
8     supervisor, Don Hajec, can be reached on (703) 308-7045. The fax phone number for this Group  
9     is (703)308-7382 or (703) 308-7722.

10                Communications via Internet e-mail regarding this application, other than those under 35  
11     U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be  
12     addressed to [daniel.felten@uspto.gov].

13                All Internet e-mail communications will be made of record in the application file. PTO  
14     employees do not engage in Internet communications where there exists a possibility that  
15     sensitive information could be identified or exchanged unless the record includes a properly  
16     signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly  
17     set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and  
18     Trademark on February 25, 1997 at 1 195 OG 89.

19                Any inquiry of a general nature or relating to the status of this application or proceeding  
20     should be directed to the Group receptionist whose telephone number is (703) 308-0956.

21                *Adf*  
22     DSF

23     June 13, 2000

  
Michael G Lee  
Primary Examiner